

## REMARKS

This communication is in response to the final Office Action issued January 23, 2006. The Examiner issued a Restriction. The Examiner rejected claims 1-14<sup>1</sup> under 35 U.S.C. § 103 in view of U.S. Patent No. 5,833,553 to Sullivan *et al.* (Sullivan).

### Withdrawal of Finality

On page 2 of the Office Action, the Examiner presented a Restriction for the first time. As such, the Office Action may not properly have been made final. *See* 37 C.F.R. § 1.142(a). Withdrawal of the finality of the January 23, 2006 Office Action is requested.

### Restriction

On page 2 of the Office Action, the Examiner issued a Restriction, alleging that due to an amendment, claims 15-21 are

directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The cover layer is a single layer that incorporates a first and second material.

The Applicants respectfully traverse the Examiner's Restriction.

A restriction is proper only if two or more "independent and distinct" inventions are claimed. 35 U.S.C. § 121. Here, however, this requirement is not satisfied. *Independent* means "that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions." MPEP § 802.01(I) (revision notes omitted). Here, both of independent claims 1 and 15 are directed to golf ball products, and are thus not independent.

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<sup>1</sup> While the Office Action actually states "[c]laims 1-15 are rejected," inclusion of claim 15 is believed to be a typographical error.

*Distinct* means “not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art).” MPEP § 802.01(II). Here, both of independent claims 1 and 15 are directed to golf ball products, and are thus connected and not distinct.

Furthermore, as the Applicants believe the Examiner’s search for each of independent claims 1 and 15 to be within the same class and likely to at least substantially overlap subclasses, examination of all pending claims presents no serious burden upon the Examiner.

Thus, it is seen that the requirements for a proper Restriction are not met. Reconsideration and withdrawal of the Restriction are requested.

#### Claim Rejections Under 35 U.S.C. § 103

On pages 2-4 of the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 103 in view of Sullivan. These rejections are improper and must be withdrawn.

As previously explained to the Examiner, Sullivan appears to disclose a low spin golf ball having a soft core and a thick, hard cover. “The cover has a Shore D hardness of 60 or more, and preferably at least 64.” Col. 2, lines 57-58 (reference character omitted). The cover may contain two or more layers, in which case each of the cover layers “have substantially the same Shore D hardness. In other words the difference between the Shore D hardness of the inner cover layer and outer cover layer is 5 or less, and preferably 2 or less. Each of the inner and outer layers has a Shore D hardness of at least 64.” Col. 3, lines 52-57 (reference characters omitted). Furthermore, also previously explained to the Examiner, Sullivan does not disclose the use of a transparent material in the cover of the golf ball. Each of the Applicants’ prior responses to the Examiner’s rejections of these claims is incorporated herein.

Nevertheless, the Examiner maintains the rejections and refuses to consider the responses previously presented by the Applicants. To justify the retention of these rejections, the Examiner makes several assertions. First, the Examiner stated that “[p]atentability cannot be granted based on aesthetic designs.” The Applicants, however, are not claiming an “aesthetic design.” Rather, the instant claims recite novel structural elements not shown in the Sullivan reference.

The Examiner next states

In regards to the hardness of the outer and inner layer [sic], the applicant uses the language “about”. The term “about” is interpreted as being “within the vicinity of”. This language does not exclude the “5” from being part of the range.

Initially, the Applicants note that the Examiner’s language is confusingly unclear. Moreover, as can best be understood, it is inaccurate. By the Examiner’s admission, the difference in the hardness of the Sullivan layers is *at most* 5 Shore D, but the Applicants recite a difference of *greater than* approximately 5 Shore D.

Next, the Examiner argues that the *Titanium Metals* case supports the assertion that the claims are not patentable. This, however, is also inaccurate. As previously explained, the *Titanium Metals* case provides that an applicant cannot obtain a patent on a newly discovered characteristic of a known alloy. Such is not the case here. The Applicants’ claims are not directed to characteristics of a known material. Rather, the instant claims are directed to a novel golf ball construction.

Finally, the Examiner states that the Applicants’ written description does not discuss spin rates and therefore arguments directed to spin rates were not considered. This is reversible error. The Examiner’s attention is kindly directed to MPEP § 716.02(f) and the case law cited therein, particularly the *In re Chu* opinion of the United States Court of Appeals for the Federal Circuit:

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at

the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded.

MPEP § 716.02(f), *citing In re Chu*, 36 U.S.P.Q.2d 1089, 1094-95 (Fed. Cir. 1995). In *In re Chu*, the applicant presented several arguments and presented evidence regarding why the recited location of one component of his invention was not a matter of “design choice.” *See* 36 U.S.P.Q.2d at 1094. The Board affirmed the Examiner’s rejection. The Federal Circuit, however, reversed, stating:

Because the Board was required to consider the totality of the record, the Board was not free to disregard the evidence and arguments presented by Chu in response to the obviousness rejection. Additionally, the Board erred in apparently requiring Chu’s evidence and arguments responsive to the obviousness rejection to be within his specification in order to be considered.

*Id.* Thus, the Examiner’s requirement that any required showing be made in the specification and refusal to consider the Applicants’ arguments presented during prosecution are in direct contrast to Federal Circuit precedent.

In view of the foregoing, the Examiner’s rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

#### Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Bingham McCutchen LLP Deposit Account No. 19-5127 (order no. 20002.0384).

#### Conclusion

Claim 1 has been amended. Claims 1-21 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner’s rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and

issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", with a stylized, cursive flourish at the end.

Sean P. O'Hanlon  
Reg. No. 47,252

Dated: April 20, 2006

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